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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,244	06/19/2001	Simon John Mantell	PC10920A	3840

7590

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Paul H. Ginsburg  
Pfizer Inc  
20th Floor  
235 East 42nd Street  
New York, NY 10017-5755

EXAMINER

YOUNG, JOSEPHINE

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 03/11/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/884,244

Applicant(s)

MANTELL

Examiner

Josephine Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-26 and 43-47, drawn to 2-alkylurea adenosine derivatives, pharmaceutical compositions, processes for their preparation, and the intermediates used in those processes, classified in class 536, subclass 25.3<sup>+</sup>, 27.3.
- II. Claims 27-42, drawn to methods to treat various diseases using said 2-alkylurea adenosine derivatives, classified in class 514, subclass 46.
- III. Claim 47, drawn to adenine derivatives, classified in class 544, subclass 264<sup>+</sup>.

Claim 47 links Groups I and III and will be examined together with either Group if elected as it pertains to the elected invention.

The inventions are distinct, each from the other because of the following reasons:

Groups I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process of Group II, i.e. the methods to treat various diseases, can be accomplished with various other agents. For example, inflammatory disease can be treated with aspirin; diabetes can be treated with insulin. The methods of Group II are

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unrelated to the products of Group III because the methods of Group II do not require any of these products.

Groups I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different Groups I and III are not related to each other for the purpose of 35 U.S.C. 121 because they are structurally distinct and not disclosed as capable of being used together. The search for one is not required for the other. Applicant is entitled to only one composition of matter.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and their recognized divergent subject matter, restriction for examination purposes as indicated is proper. A reference for one group could not reasonably be expected to be a reference for another. Further, searching both the inventions constitutes a burdensome search, as a thorough search comprises a search of foreign patents and non-patent literature, as well as the appropriate U.S. patent classifications. To search the three independent and distinct inventions, set forth supra, would indeed impose an undue burden upon the examiner in charge of this application.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even if the requirement is traversed (37 CFR 1.143).

If Group I is elected, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, as well as the corresponding process(es) and intermediate(s) for preparing said species,

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for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-26 and 43-47 of Group I are generic.

Group I of this application contains claims directed to the following patentably distinct species of the claimed invention: compounds and processes for the preparation of said compound wherein

Y is (a-1) CO or CS; (b-1) SO<sub>2</sub>; or (c-1) C(=N-CN); and

R<sup>3</sup> is (a-2) H, C<sub>1</sub>-C<sub>6</sub> alkyl, C<sub>3</sub>-C<sub>8</sub> cycloalkyl or benzyl; or (b-2) taken together with R<sup>4</sup> and the nitrogen atom to which they are attached to represent a heterocycle; and

R<sup>5</sup> is (a-3) CH<sub>2</sub>OH; or (b-3) CONR<sup>14</sup>R<sup>14</sup>;

such that each independent species is directed to a distinct Y, R<sup>3</sup> and R<sup>5</sup>.

Similarly, if Group II is elected, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 27-42 of Group II are generic.

Group II of this application contains claims directed to the following patentably distinct species of the claimed invention:

Methods for the treatment of (A-1) an inflammatory disease; (B-1) a respiratory disease; or (C-1) another disease that is neither a respiratory disease nor an inflammatory disease; comprising administering one of the distinct species described above, namely a compound wherein

Y is (a-1) CO or CS; (b-1) SO<sub>2</sub>; or (c-1) C(=N-CN); and

R<sup>3</sup> is (a-2) H, C<sub>1</sub>-C<sub>6</sub> alkyl, C<sub>3</sub>-C<sub>8</sub> cycloalkyl or benzyl; or (b-2) taken together with R<sup>4</sup> and the nitrogen atom to which they are attached to represent a heterocycle; and

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$R^5$  is (a-3)  $CH_2OH$ ; or (b-3)  $CONR^{14}R^{14}$ ;

such that each independent species is directed to a distinct disease using a compound with a distinct  $Y$ ,  $R^3$  and  $R^5$ .

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

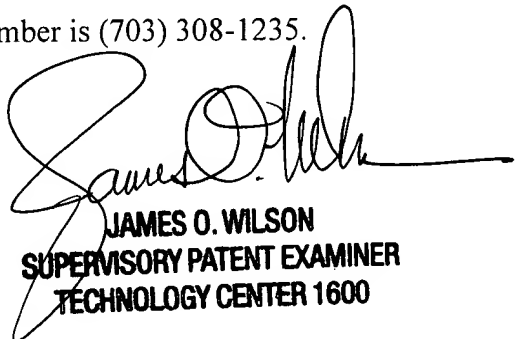
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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Josephine Young whose telephone number is (703) 605-1201. The examiner can normally be reached on Monday through Friday, 9:00 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached at (703) 308-4624. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



**JAMES O. WILSON**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**

JY

March 5, 2003